



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Glenn McGall, Martin Goldberg, Thomas B. Ryder and Steve Woodman

Application No.: 09/862,571

Group: 1631

Filed: May 21, 2001

Examiner: Borin, Michael L.

Conf. No.: 9482

For: METHODS FOR REDUCING NON-SPECIFIC BINDING TO AN OLIGONUCLEOTIDE ARRAY

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| on <u>9/18/02</u> | <u>Daniel L. Matson</u> |
| Date | Signature |
| <u>DANIEL L. MATSON</u> | |
| Typed or printed name of person signing certificate | |

Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Sir:

Transmitted herewith is a Sequence Listing and a Preliminary Amendment for filing in the above-identified application.

[] Small entity status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a Small Entity Statement previously submitted.

[] A Small Entity Statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

The fee has been calculated as shown below:

| (COL. 1) | (COL. 2) | (COL. 3) | (COL. 4) | (COL. 5) |
|--|---|----------|---------------------------------------|------------------|
| | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NO. PREVIOUSLY PAID FOR | PRESENT EXTRA |
| TOTAL | 42 | MINUS | * 42 | 0 |
| INDEP | 9 | MINUS | ** 9 | 0 |
| <input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM | | | | |

* not fewer than 20
** not fewer than 3

| SMALL ENTITY | |
|--------------|---------------|
| RATE | ADDIT. FEE |
| X \$ 9 | \$ 0 |
| X \$42 | \$ 0 |
| + \$140 | \$ 0 |

TOTAL = \$ 0

| OTHER THAN SMALL ENTITY | |
|----------------------------|---------------|
| RATE | ADDIT. FEE |
| X \$18 | \$ 0 |
| X \$84 | \$ 0 |
| + \$280 | \$ 0 |

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| <input type="checkbox"/> | Amendment Fee | \$ _____ |
| <input type="checkbox"/> | Other Fees: | |
| | _____ | \$ _____ |
| | _____ | \$ _____ |
| | TOTAL: | \$ <u>0</u> |

☒ A general authorization is hereby granted to charge Deposit Account No. 08-0380 for any fees required under 37 C.F.R. 1.16 and 1.17 in order to maintain pendency of this application. A copy of this authorization is enclosed for accounting purposes.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Lisa M. Treannie
Lisa M. Treannie
Registration No.: 41,368
Telephone (978) 341-0036
Facsimile (978) 341-0136

Concord, Massachusetts 01742-9133

Dated: 9/18/02

1631



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants: Glenn McGall, Martin Goldberg, Thomas B. Ryder and Steve Woodman

Application No.: 09/862,571

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| Date | Signature |
| <u>DIANE L. MATSON</u> | |
| Typed or printed name of person signing certificate | |

TRANSMITTAL OF INFORMAL DRAWING

Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Sir:

Transmitted herewith is an informal drawing consisting of 1 sheet, Figure 3, for filing in the subject patent application.

It is unclear whether Figure 3 was inadvertently omitted from the application as filed. As a precaution, Figure 3 is transmitted herewith. Figure 3 was present in U.S.S.N. 09/063,311,

filed April 20, 1998, which was incorporated by reference into the subject application (copy of Utility Patent Application Transmittal enclosed). Thus, no new matter is added.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Lisa M. Treannie

Lisa M. Treannie, Esq.

Registration No. 41,368

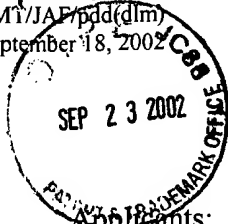
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Date: 9/16/02

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Glenn McGall, Martin Goldberg, Thomas B. Ryder and Steve Woodman
Application No.: 09/862,571 Group: 1631
Filed: May 21, 2001 Examiner: Borin, Michael L.
Conf. No.: 9482
For: METHODS FOR REDUCING NON-SPECIFIC BINDING TO AN
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SECOND REQUEST FOR CORRECTED FILING RECEIPT
FOR UTILITY APPLICATION

Office of Initial Patent Examination
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Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Sir:

We hereby request that the following items of information be corrected in the Filing Receipt for the subject application received in this office on July 15, 2002.

A copy of the Express Mail label, the Utility Patent Application Transmittal and the Remarks Letter are submitted herewith.

The errors and corrections appear below.

Please change the Filing date from "May 23, 2001" to - - - May 21, 2001- - - .

The correct filing date of the application is May 21, 2001, as indicated on the enclosed copies of:

1. The Express Mail Label referencing the Attorney Docket Number of the subject application and showing a deposit date of May 21, 2001;
2. The Utility Application Transmittal with the subject Express Mail Label number affixed; and
3. The Remarks Letter referencing the same Express Mail Label number.

Enclosed is a copy of the Filing Receipt with changes noted in red, and copies of the supporting documents listed above.

Pursuant to instructions in the February 29, 2000 O.G., we hereby request that the errors which are identified above be corrected in the captioned application to which this request for correction is directed. It is understood that the Patent Office will issue an automatically-generated, corrected Filing Receipt in this and, if applicable, any other affected applications.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Lisa M. Treannie

Lisa M. Treannie

Registration No.: 41,368

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

Date: 9-18-02



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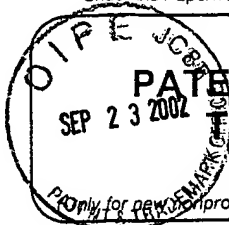
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UTILITY
PATENT APPLICATION
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Only for new provisional applications under 37 C.F.R. § 1.53(b)

| | |
|------------------------|---|
| Attorney Docket No. | 018547-033110; Client No. 3054 |
| First Inventor | McGall et al. |
| Title | METHODS FOR REDUCING NON-SPECIFIC BINDING TO AN OLIGONUCLEOTIDE ARRAY |
| Express Mail Label No. | EL 801719926 US |

| APPLICATION ELEMENTS | ADDRESS TO |
|---|---|
| See MPEP chapter 600 concerning design patent application contents. | Assistant Commissioner for Patents Box Patent Application Washington, DC 20231 |
| 1. <input checked="" type="checkbox"/> Fee Transmittal Form (e.g., PTO/SB/17) (Submit an original and a duplicate for fee processing) | 7. <input type="checkbox"/> CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix) |
| 2. <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. | 8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary) |
| 3. <input checked="" type="checkbox"/> Specification (Total Pages <u>63</u>) (preferred arrangement set forth below) - Descriptive title of the invention - Cross References to Related Applications - Statement Regarding Fed sponsored R & D - Reference to sequence listing, a table, or a computer program listing appendix - Background of the invention - Brief Summary of the invention - Brief Description of the Drawings (if filed) - Detailed Description - Claim(s) - Abstract of the Disclosure | a. <input type="checkbox"/> Computer Readable Form (CRF) b. Specification Sequence Listing on: i. <input type="checkbox"/> CD-ROM or CD-R (2 copies); or ii. <input type="checkbox"/> paper number of pages c. <input type="checkbox"/> Statements verifying identity of above copies |
| 4. <input checked="" type="checkbox"/> Drawing(s) (35 U.S.C.113) (Total Sheets <u>2</u>) | ACCOMPANYING APPLICATIONS PARTS |
| 5. Oath or Declaration (Total Pages <u>4</u>) a. <input type="checkbox"/> Newly executed (original or copy) b. <input checked="" type="checkbox"/> Copy from a prior application (37 CFR 1.63 (d)) (for a continuation/divisional with Box 18 completed) i. <input type="checkbox"/> DELETION OF INVENTOR(S) Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b). | 9. <input type="checkbox"/> Assignment Papers (cover sheet & document(s)) 10. <input type="checkbox"/> 37 C.F.R. § 3.73(b) Statement <input type="checkbox"/> Power of (when there is an assignee) Attorney 11. <input type="checkbox"/> English Translation Document (if applicable) 12. <input type="checkbox"/> Information Disclosure <input type="checkbox"/> Copies of IDS Statement (IDS)/PTO-1449 Citations 13. <input type="checkbox"/> Preliminary Amendment 14. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) (Should be specifically itemized) 15. <input type="checkbox"/> Certified Copy of Priority Document(s) (if foreign priority is claimed) 16. <input type="checkbox"/> Request and Certification under 35 U.S.C. 122(b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent 17. <input checked="" type="checkbox"/> Other: (1) Petition for Extension of Time Under 37 CFR 1.136(a); (2) Remarks |
| 6. <input type="checkbox"/> Application Data Sheet. See 37 CFR 1.76 | |

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☒ Continuation ☐ Divisional ☐ Continuation-in-part (CIP)of prior application No: 09 / 063,311

Prior application information:

Examiner J. LundgrenGroup Art Unit: 1631

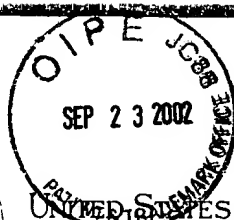
For CONTINUATION or DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

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|-------------------|------------|-----------------------------------|--------------|
| Name (Print/Type) | Don D. Cha | Registration No. (Attorney/Agent) | 40,945 |
| Signature | | Date | May 21, 2001 |

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| APPLICATION NUMBER | FILING DATE | GRP ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO. | DRAWINGS | TOT CLAIMS | IND CLAIMS |
|--------------------|---------------------------------------|--------------|---------------|------------------|----------|------------|------------|
| 09/862,571 | 05/23/2001 May 21, 2001 | 1631 | 1586 | 2719.2019-001 | 2 | 42 | 9 |

21005
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

CONFIRMATION NO. 9482
CORRECTED FILING RECEIPT



OC00000008423123

Date Mailed: 07/10/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Glenn McGall, Mountain View, CA;
Martin Goldberg, San Jose, CA;
Thomas B. Ryder, Los Gatos, CA;
Steve Woodman, San Jose, CA;

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CON OF 09/063,311 04/20/1998 ABN

Foreign Applications

If Required, Foreign Filing License Granted 07/02/2001

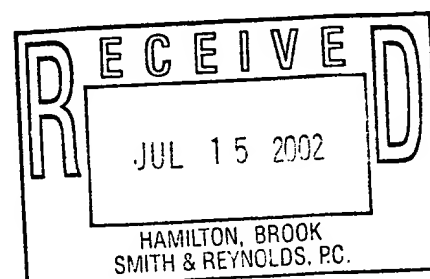
Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Methods for reducing non-specific binding to an oligonucleotide array



Preliminary Class

435

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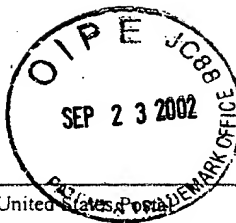
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PATENT

Attorney Docket No.: 018547-033110US

Client Reference No.: 3054

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Assistant Commissioner for Patents

Washington, D.C. 20231

By: Bonnie Reckle

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

McGall et al.

Filed: Herewith

For: METHODS FOR REDUCING
NON-SPECIFIC BINDING TO AN
OLIGONUCLEOTIDE ARRAY

Examiner:

Art Unit:

REMARKS

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REMARKS

This is a Continuation Application of U.S. Patent Application No. 09/0631,311, filed April 20, 1998. Enclosed herewith is a Petition for three-months extension of time for the parent application thereby extending the due date for response to the parent application from February 21, 2001 to May 21, 2001. The Petition for Extension of Time preserves the co-pendency of the parent application and the present continuation application.

Respectfully submitted,

Don D. Cha

Reg. No. 40,945

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DE 7040967 v1